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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,282	03/26/2004	Richard L. Parton	87152AEK	8579

7590 10/16/2007
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343 State Street
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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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10/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,282	Applicant(s) PARTON ET AL.	
	Examiner Marie R. Yamnitzky	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-25 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-25 and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions (amendment and Rule 131 declaration) filed on July 30, 2007 have been entered.

2. Applicant's amendment filed July 30, 2007 amends claims 15 and 18.

Claims 1-16, 18-25 and 28-33 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Applicant's arguments filed July 30, 2007 regarding the rejection under 35 U.S.C. 112, 1st paragraph, as set forth in the Office action mailed April 26, 2007 are persuasive. The rejection is withdrawn.

4. Claims 1-4, 6-11, 21, 22, 24, 25, 30, 32 and 33 stand rejected under 35 U.S.C. 102(e) as being anticipated by Matsuura et al. (US 2005/0064233 A1) for reasons of record in the Office action mailed April 26, 2007.

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5. Claims 1-16, 18-25, 30, 32 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuura et al. (US 2005/0064233 A1) for reasons of record in the Office action mailed April 26, 2007.

6. The declaration filed on July 30, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejections based on the Matsuura et al. reference. The prior art discloses several species within the scope of the present generic claims and some of the present narrower claims. Applicant has not shown prior possession of the species shown in the reference that are within the scope of the present claims (i.e. Matsuura's compounds of formulae EM127, EM128, EM129, EM130 and EM192). Applicant has not shown that the species shown in the reference would have been obvious in view of the species shown in the declaration.

7. Claims 1-16, 18-25 and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Parton et al. (US 2003/0129449 A1) for reasons of record in the Office action mailed April 26, 2007 with the following modification.

The Parton et al. publication was previously applied under 35 U.S.C. 103(a) via 102(a) as well as via 102(e). Given the statement of common ownership set forth in applicant's arguments filed July 30, 2007, the rejection under 35 U.S.C. 103(a) via 102(e) is overcome. The rejection stands under 35 U.S.C. 103(a) via 102(a).

8. The declaration filed on July 30, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the rejection based on the Parton et al. reference.

The Parton et al. reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. (Note that the “same patentable invention” as used here includes inventions that are obvious over each other.) If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Even if applicant were to persuade the examiner that the reference is not claiming the same patentable invention, it is the examiner’s position that the Rule 131 Declaration is insufficient to overcome the rejection based on the Parton et al. publication because the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the reference. Parton’s priority application No. 09/966,278, filed September 28, 2001, provides support for Parton’s teachings that are relied upon in rejecting the claims under 35 U.S.C. 103(a). The Rule 131 Declaration speaks of dates prior to April 2, 2003. It is not clear that the dates prior to April 2, 2003 are necessarily prior to September 28, 2001.

9. Applicant's arguments and the Rule 132 declaration filed July 30, 2007 reference EP 1298738 as a counterpart to US publication 2003/0129449.

There are four patent family members related to Parton et al. U.S. Application No. 10/145,363: US 2003/0129449 A1, US 6,849,345 B2, EP 1298738 A2 (published April 02, 2003) and JP 2003133076 A (published May 09, 2003).

During prosecution of the present application, rejections under 35 U.S.C. 102(a), 102(e) and 35 U.S.C. 103(a) via 102(a) and 102(e) were made based on the US '449 A1 publication. An obviousness-type double patenting rejection was made based on the US '345 B2 patent.

The rejections under 35 U.S.C. 102(a) and 102(e) based on the US '449 A1 publication were overcome by amendment.

The obviousness-type double patenting rejection based on the US '345 B2 patent was overcome by the filing of a terminal disclaimer.

The US '345 B2 patent is not available under 35 U.S.C. 102(a). No rejections were made under 35 U.S.C. 102(e) or 103(a) via 102(e) based on the US '345 B2 patent as such rejections were considered to be duplicative of the corresponding rejections based on the US '449 A1 publication. The amendments which overcame the 102(a) and 102(e) rejections based on the US '449 A1 publication also would have overcome the 102(e) rejection that could have been made based on the US '345 B2 patent. The rejection under 35 U.S.C. 103(a) via 102(e) based on the US '449 A1 publication is overcome by the statement of common ownership set forth in applicant's arguments filed July 30, 2007. Since the US '449 A1 publication and the US '345 B2 patent are the publication and patent, respectively, of the same US application, applicant's

statement of common ownership is considered by the examiner to be sufficient to overcome the 103(a) rejection that could have been made based on the US '345 B2 patent.

The EP '738 A2 and JP '076 A documents were/are not available under 35 U.S.C. 102(b) or 102(e). No rejections under 35 U.S.C. 102(a) or 103(a) via 102(a) were made based on these documents. The rejection that could have been made under 102(a) based on the EP and JP documents would have been overcome by the amendment that overcame the corresponding rejection based on the US '449 A2 publication. The rejection that could have been made under 103(a) via 102(a) based on the EP and JP documents would have been withdrawn in light of the Rule 131 declaration filed July 30, 2007.

10. Miscellaneous:

The first paragraph of applicant's remarks filed July 30, 2007 indicate that certain changes have been made to claims 15 and 21. The examiner notes that claim 15 has been amended differently than stated, and claim 21 has not been amended. Claim 18 has been amended similarly to claim 15. Applicant is respectfully requested to review the changes suggested by the examiner in the prior Office action versus present claims 15 and 21, and reconsider the effect of the amendment to claim 18 (no change to 18 was necessary).

11. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday.

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The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
October 11, 2007



MARIE YAMNITZKY
PRIMARY EXAMINER

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